Andrew P. Bridges (SBN: 122761)
abridges@winston.com
Matthew A. Scherb (SBN: 237461)
mscherb@winston.com
Kathleen Lu (SBN: 267032)
klu@winston.com
WINSTON & STRAWN LLP
101 California Street
San Francisco, CA 94111-5802
Telephone: (415) 591-1000
Facsimile: (415) 591-1400

Attorneys for Movants
ELECTRONIC FRONTIER FOUNDATION and
FRED VON LOHMANN

Winston & Strawn LLP
101 California Street
San Francisco, CA 94111-5802

UNITED STATES DISTRICT COURT

NORTHERN DISTRICT OF CALIFORNIA

SAN FRANCISCO DIVISION

JSW

CV 10 80 276 MISC

In re Subpoenas to Electronic Frontier Foundation and Fred von Lohmann

Case No. _____

[Related to *Arista Records v. Lime Wire LLC*, No. 06-5936 (KMW) (S.D.N.Y.)]

EXPEDITED MOTION TO QUASH SUBPOENAS

Date: November 19, 2010
(proposed by stipulation of Movant and Plaintiffs, awaiting order)

Winston & Strawn LLP
101 California Street
San Francisco, CA 94111-5802

I. INTRODUCTION

The Electronic Frontier Foundation (EFF), a nonprofit law firm championing the public interest in innovation and civil liberties in the digital world, and Fred von Lohmann, formerly one of its lawyers, challenge subpoenas that seek testimony and documents concerning their client Lime Wire. These subpoenas represent a brazen attempt to invade the attorney-client relationship. They strike at the very notion, core to our system of justice, that lawyers can provide advice to clients in confidence. The subpoenas also seek irrelevant information, seek unobtainable expert opinions, and impose undue burdens on the EFF and Mr. von Lohmann. Further, the subpoenas seek depositions and production of documents on November 23, 2010, an extraordinarily short time frame that is unworkable and necessitates quick intervention from this Court. The EFF and Mr. von Lohmann urge the Court to quash these subpoenas before November 23, 2010. (The subpoenas originally called for documents and depositions by November 12. The parties agreed to November 23 in order to accommodate briefing and hearing this motion.)

II. FACTUAL BACKGROUND

Beginning in approximately 2002-2003, Lime Wire personnel contacted EFF personnel, including attorney Fred von Lohmann,[1] seeking legal advice related to Lime Wire's file sharing service.

In 2006, thirteen record labels sued Lime Wire and some of its personnel in the U.S. District Court for the Southern District of New York for alleged copyright infringement related to sharing of copyrighted sound recordings on the Lime Wire service. *Arista Records LLC v. Lime Group LLC*, No. 06-5936 (S.D.N.Y.). Naturally, the EFF and defendants' primary litigation counsel exchanged some communications during the course of the lawsuit.

On May 25, 2010, Judge Kimba Wood of the Southern District granted summary judgment on several of the record labels' claims. *Arista Records LLC v. Lime Group LLC*, __ F. Supp. 2d __, No. 06-5936, 2010 WL 2291485 (S.D.N.Y. May 25, 2010). The case now proceeds to trial on damages. Discovery for the damages phase is currently set to close on November 25, 2010.

[1] Mr. von Lohmann left the EFF in June 2010.

Winston & Strawn LLP
101 California Street
San Francisco, CA 94111-5802

After four years of litigation, the record labels served last-minute subpoenas on the EFF, on October 27, 2010, and Mr. von Lohmann, on November 2, 2010. The subpoenas accompany the Declaration of Matthew Scherb as Exhibits A and B. Each subpoena called for a deposition and seeks production of various categories of documents by November 12 (now November 23), 2010.

Counsel for EFF and Mr. von Lohmann have conferred with counsel for the record labels. They agreed that the EFF and Mr. von Lohmann would serve this motion on Monday, November 8, 2010 (with filing on November 9), with an opposition due by November 12, 2010, and a reply by November 16, 2010. The parties agreed to request a hearing in the Court on November 19, 2010.

III. ARGUMENT

Under Federal Rule of Civil Procedure 45(c)(3)(A), "the issuing court *must* quash or modify a subpoena" (emphasis added) when the subpoena "requires disclosure of privileged or other protected matter," *id.* R. 45(c)(3)(A)(iii), "subjects a person to undue burden," *id.* R. 45(c)(3)(A)(iv), or "fails to allow a reasonable time to comply," *id.* R. 45(c)(3)(A)(i). An issuing court may quash a subpoena if it requires "disclosing an unretained expert's opinion or information that does not describe specific occurrences in dispute and results from the expert's study that was not requested by a party." *Id.* R. 45(c)(3)(B)(ii). Quashing the subpoenas is appropriate on each of these grounds.

A. The Subpoenas Impermissibly Seeks Core Attorney-Client Privileged and Work Product Materials.

The Court "*must* quash or modify a subpoena" when the subpoena "requires disclosure of privileged or other protected matter" or imposes an "undue burden." Fed. R. Civ. P. 45(c)(3)(A)(iii)-(iv).

The EFF and its attorney Mr. von Lohmann began providing legal advice to Lime Wire in approximately 2002-2003. Privilege arises from the first consultation: even "communications made in the course of preliminary discussions with a view to employing the lawyer are privileged" whether the attorney accepts the employment or not. *In re Auclair*, 961 F.2d 65, 69 (5th Cir. 1992) (cited in 1 Rice, Attorney Client Privilege in the United States, § 2-4 (2d. Ed. 2007 & 2010 Supp.).[2]

[2] During discovery in the Southern District action, Defendants, through prior counsel, may have produced some communications between themselves and Movants, such as public listserv or mailing list communication and general updates shared with numerous recipients. Defendants logged other documents on a privilege log. Movants have not had the time to fully assess the different categories

The subpoenas overwhelmingly seek to penetrate the attorney-client relationship between the EFF and Lime Wire and to uncover confidential communications. This Court reject attempts to undermine the attorney-client relationship in this fashion. *Nocal, Inc. v. Sabercat Ventures, Inc.*, No. 04-240, 2004 WL 3174427 (N.D. Cal. Nov. 15, 2004); *Unigene Laboratories, Inc. v. Apotex, Inc.*, No. 07-80218, 2007 WL 2972931 (N.D. Cal. Oct. 10, 2007).

In *Unigene Laboratories*, this Court quashed a subpoena to one of defendant's former attorneys. The plaintiff wanted to depose the former attorney about a certification letter that she had prepared and which bore some relationship to the plaintiff's lawsuit. The Court refused, quashing the deposition subpoena and finding that "any information relevant to the [parties'] controversy, whether technical or legal, falls within the protection of the attorney-client privilege." 2007 WL 2972931, at *3. Similarly, in *Nocal*, this Court quashed a deposition and document subpoena purportedly requiring the one of the parties' attorneys to give testimony and produce documents. 2004 WL 3174427, at *2-4.

Protecting attorneys from having to breach client confidence is an "obvious" reason for quashing a subpoena. *Knepp v. United Stone Veneer, LLC.*, No. 06-1018, 2007 WL 4437225, (M.D. Pa. Dec. 14, 2007) (quashing a subpoena for deposition and documents).

Here, the subpoenas seek a deposition of the EFF and Mr. von Lohmann on topics that, with one exception, relate to "communications between EFF and the Lime Wire Entities or Gorton"[3] about Lime Wire and alleged copyright infringement. (Scherb Decl. Exh. A.) These "communications" are core attorney-client privileged material. The only other topic, topic number two, is "EFF's knowledge, understanding, or analysis of the actual or potential use of Lime Wire to share copyrighted material." Though the topic does not use the word "communications," the EFF would not acquire any relevant knowledge or understanding, or be able to conduct any analysis, of uses of Lime Wire without either having and utilizing confidential communications with Lime Wire or conducting its own expert analysis, either of which would be protected as privileged. Thus, there

of documents given the fast pace of events. Regardless, any produced documents are already in the hands of Plaintiffs and Plaintiffs have no need for them from Movants. Further, the produced documents are either not privileged or, if privileged, inadvertently produced. Movants understand from Defendants' current counsel that they continue to assert privilege in communications with Movants.

[3] Gorton is one of Lime Wire's personnel.

Winston & Strawn LLP
101 California Street
San Francisco, CA 94111-5802

is absolutely nothing the subpoenas seek to learn in deposition that is *not* attorney-client privileged. The same analysis applies to the subpoenas' document requests. They seek nothing but the contents of privileged communications, including, for example, the state of mind of Lime Wire personnel or the EFF's expert legal analyses. The privilege protects not only communications themselves, but also attorneys' notes and memoranda containing them. *Trout v. Nationwide Mut. Ins. Co.*, No. 06-236, 2006 WL 2683731, at *2 (D. Colo. Sept. 19, 2006); *Cedrone v. Unity Sav. Ass'n*, 103 F.R.D. 423, 429 (E.D. Pa. 1984) ("[I]t is inconceivable that an internal memorandum between attorneys in the same office concerning the representation of a client, utilizing confidential information provided by that client, could be anything but protected by the privilege.").

Even if the Court were to conclude that the subpoenas do not seek only attorney-client privileged material, exposing a litigant's attorney to the subpoena power undermines clients' trust in attorneys and the public's trust in its judiciary. The EFF and Mr. von Lohmann cannot effectively represent clients if they and prospective clients operate under the fear that a Court will later force disclosure of what all thought were confidential communications. Given this, and given that the subpoenas seek information that is not relevant or of marginal relevance, given that the Southern District of New York case is now in the damages phase, and seek information that Lime Wire can itself provide, the subpoenas impose an undue burden and the Court should also quash them on this basis.

Shelton v. American Motors Corp., 805 F.2d 1323 (8th Cir. 1986) is the leading case cautioning against allowing depositions and discovery from attorneys of litigants, even when the attorney-client privilege cannot alone prevent the discovery. The Eighth Circuit "view[ed] the increasing practice of taking opposing counsel's deposition as a negative development in the area of litigation." 805 F.2d at 1327. It also believed that the practice "increases the costs of litigation, demeans the profession, and constitutes an abuse of the discovery process." *Id.* at 1330. It reasoned that:

> Taking the deposition of opposing counsel not only disrupts the adversarial system and lowers the standards of the profession, but it also adds to the already burdensome time and costs of litigation. It is not hard to imagine additional pretrial delays to resolve work-product and attorney-client objections, as well as delays to resolve collateral issues raised by the attorney's testimony. Finally, the practice of deposing opposing counsel detracts from the quality of client representation. Counsel should be free to devote his or her time and efforts

Winston & Strawn LLP
101 California Street
San Francisco, CA 94111-5802

> to preparing the client's case without fear of being interrogated by his or her opponent. Moreover, the "chilling effect" that such practice will have on the truthful communications from the client to the attorney is obvious.

Id. at 1327. Therefore, a deposition of an adversary's counsel should only take place if (1) no other means exist to obtain the information; (2) the information sought is relevant and nonprivileged; and (3) the information is crucial to the preparation of the case. *Id. Shelton*, in addition to concluding that the information that plaintiff sought from an in-house attorney was privileged, held that other means existed to obtain the information. The Eighth Circuit told plaintiff it could and did get answers to its questions from defendant, and it was not entitled to verify the truth of defendant's statements by deposing defendant's attorney. *Id.* at 1327-28.

This Court adheres to the warnings in *Shelton*, and, in fact, has used the case as a springboard to deny deposition and document discovery when a subpoenaing party did not meet the *Shelton* requirements and when, in light of that, the subpoena was unduly burdensome. *Nocal*, 2004 WL 3174427, at *2-4. This Court also embraces the "general presumption that lawyers should not be called to testify in cases where their client is a party because doing so compromises the standards of the legal profession." *Fausto v. Credigy Services Corp.*, No. 07-5658, 2008 WL 4793467, at *1 (N.D. Cal. Nov. 3, 2008).

Not only do the subpoenas here seek solely attorney-client and work product privileged material (as discussed above), to the extent the EFF or Mr. von Lohmann had communications with defendants or their counsel after defendants anticipated litigation, the work product privilege and common interest doctrine also apply with respect to other representations as well.

Further, the subpoenas seek information that others can provide and is not relevant, let alone crucial, to the record labels' case. First, as in *Shelton*, the record-label plaintiffs are able to obtain non-privileged discovery from the defendants on Lime Wire's operation and defendants' state of mind. Plaintiffs have no right to duplicate access to this information by harassing defendants attorneys. Second, in light of the availability of discovery from defendants and in light of the Southern District of New York litigation being into the damages stage, many of the subpoenas' document request and parallel deposition topics seek irrelevant or only marginally relevant testimony and documents. *Cf. Compaq Computer Corp. v. Packard Bell Electronics, Inc.*, 163

Winston & Strawn LLP
101 California Street
San Francisco, CA 94111-5802

F.R.D. 329, 335 (N.D. Cal. 1995) ("[I]f the sought-after documents are not relevant nor calculated to lead to the discovery of admissible evidence, then *any burden whatsoever* imposed upon [the non-party] would be by definition 'undue'"). As crucial as evidence preservation is to fair litigation, it is not at issue in a damages trial. (*See* Document Request 1 of both subpoenas.) Nor does a damages trial deal with issues related to liability, such as general use of Lime Wire for sharing copyrighted materials (Request 2), actual or potential download monitoring (Request 3), the design of Lime Wire ***or other peer-to-peer services*** (Request 4), defendants' general state of mind about unspecified features of Lime Wire (Request 5), or anticipated litigation (Request 8).

B. **The Subpoenas, As Drafted, Otherwise Seek Irrelevant Documents and Testimony Which Are Also Likely Attorney-Client Privileged Communications or Work Product Related to Other EFF Clients or Unretained Expert Opinion.**

To the extent the subpoenas may seek any documents and testimony other than attorney-client privileged material (they do not), they seek only irrelevant material, much of which would be subject to other clients' claims of privilege or classified as reports of EFF as an unretained expert. None of these materials should be subject to production in connection with the Southern District lawsuit.

When advising other clients, the EFF or Mr. von Lohmann may have mentioned publicly available information about the Lime Wire service or the litigation involving Lime Wire. To the extent the EFF and Mr. von Lohmann included this information in communications to other clients, those communications and related work product are protected from disclosure. Fed. R. Civ. P. 45(c)(3)(A)(iii). In addition, to the extent the EFF and its personnel have engaged in their own internal review and analysis of the Southern District litigation, the fruits of that review and analysis would constitute unretained expert opinion, which the Court should not compel the EFF or its personnel to produce. *Id.* R. 45(c)(3)(B)(ii);*Mattel, Inc. v. Walking Mountain Productions*, 353 F.3d 792, 814 (9th Cir. 2003) ("Rule 45(c)(3)(B)(ii) was intended to provide appropriate protection for the intellectual property of non-party witness.... A growing problem has been the use of subpoenas to compel the giving of evidence and information by unretained experts.").

Moreover, any documents or information that the EFF or Mr. von Lohmann has prepared

Winston & Strawn LLP
101 California Street
San Francisco, CA 94111-5802

for other clients or the public – in fact, any documents unprotected by privilege – are absolutely irrelevant to the Southern District of New York action. If the EFF reported on the Lime Wire litigation or discussed it internally, documents and testimony reflecting that would have no bearing on damages, let alone liability (which the court already determined with its May 2010 decision).

C. The Subpoenas Are Unduly Burdensome Not Only Because they Undermine the Attorney-Client Relationship and Judicial Process While Seeking Irrelevant Information, But Also Because They Would Impose Great Costs on Non-Parties Ill Equipped to Bear Them.

Further, the EFF and Mr. von Lohmann's compliance with the subpoenas will cost many thousands of dollars for data collection and processing and result in significant attorney time spent on reviewing documents for responsiveness and privilege. These costs, which cannot be known fully at this time, will be substantial. Based on these costs, combined with the Subpeonas' disdain for the attorney-client relationship and requests for marginally relevant information, the Court should find that the subpoenas create an undue burden and must be quashed. *Nocal*, 2004 WL 3174427 at *3; *cf.* Fed. R. Civ. P. 26(b)(2)(C) (courts must prevent discovery when its burden outweighs its benefit); *Cusumano v. Microsoft Corp.*, 162 F.3d 708, 714 (1st Cir. 1998) (applying Rule 26 limits on discovery as additional limits on Rule 45 subpoena discovery); *Compaq,* 163 F.R.D. at 335.

D. If the Court Does Not Quash the Subpoenas, It Should Order Cost Shifting.

Finally, if the Court does not quash the subpoenas entirely, the EFF and Mr. von Lohmann request the Court to shift all costs of compliance, including attorney fees and costs, to the record-label plaintiffs.

The record labels have taken no reasonable steps to avoid imposing undue burdens or expenses, Fed. R. Civ. P. 45(c)(1), (c)(3)(A)(iv), and have not agreed to compensate the EFF or Mr. von Lohmann for the time and costs associated with document production. A court must protect a non-party from "significant expense" resulting from compliance with a subpoena. Fed. R. Civ. P. 45(c)(2)(B)(ii). The EFF and Mr. von Lohmann, and their counsel, are "entitled to be compensated at a reasonable hourly rate [for] . . . time in searching for, reviewing for privileged material and

Winston & Strawn LLP
101 California Street
San Francisco, CA 94111-5802

producing responsive documents," if any. *Compaq*, 163 F.R.D. at 339; *Pacific Gas & Elec. Co. v. Lynch*, No. C-01-3023, 2002 WL 32812098, at *3 (N.D. Cal. Aug. 19, 2002) (awarding cost of "legal work") ("[C]ourts are required to condition compelled production by a non-party on the payment of at least some portion of costs of production by the serving party."). "Nonparty witnesses are powerless to control the scope of litigation and discovery, and should not be forced to subsidize an unreasonable share of the costs of a litigation to which they are not a party." *United States v. Columbia Broad. Sys., Inc.*, 666 F.2d 364, 371 (9th Cir. 1982), *cert. denied*, 457 U.S. 1118 (1982).

Shifting of costs and attorneys fees to the record labels, each a large corporation engaging in vigorous and even aggressive litigation, is especially appropriate in this case when the EFF is a nonprofit organization and Mr. von Lohmann is an individual, both with limited financial resources. Neither should be forced to subsidize others' litigation efforts to jeopardize the trust of their clients.

IV. CONCLUSION

The EFF and Mr. von Lohmann request the Court to quash the subpoenas, or, in the alternative, to limit them and to shift all costs and fees of compliance to the record labels.

Dated: November 8, 2010

WINSTON & STRAWN LLP

By: Andrew P. Bridges

Andrew P. Bridges
Matthew A. Scherb
Kathleen Lu

Attorneys for Movants.
ELECTRONIC FRONTIER FOUNDATION and
FRED VON LOHMANN

Winston & Strawn LLP
101 California Street
San Francisco, CA 94111-5802